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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,506	07/16/2003	Arno Schmuck	07244-00134-US	8475
23416	7590	09/20/2005	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			PAIK, STEVE S	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H/A

**Office Action Summary**

Application No.

10/620,506

Applicant(s)

SCHMUCK ET AL.

Examiner

Steven S. Paik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/11/04; 10/14/03.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Response to Amendment***

2. Receipt is acknowledged of the Preliminary Amendment filed July 16, 2003.

### ***Drawings***

3. The examiner notes that there is no drawing filed with the application. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

### ***Information Disclosure Statement***

4. The information disclosure statement filed October 14, 2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Page 2 of 2 of the IDS lists 26 research disclosures without a concise explanation of the relevance. The examiner respectfully requests the applicant to provide a concise explanation of

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the relevance. The other references on the IDS and another Ids filed on March 11, 2004 have been considered by the examiner.

### *Specification*

5. Applicant(s) are reminded to include the following in the next communication with respect to the header(s) within the specification, as following:

a) -- **Background of the Invention** --: The specification should set forth the Background of the Invention in two parts: -- **Field of the Invention** -- and -- **Description of the Related Art** --.

b) \_\_\_\_\_ -- **Brief Summary of the Invention** --.

c) \_\_\_\_\_ -- **Brief Description of the Several Views of the Drawing(s)** --.

d) \_\_\_\_\_ -- **Detailed Description of the Invention** --.

Appropriate correction is required.

### *Claim Objections*

6. Claims 5, 6, 10 and 11 are objected to because of the following informalities: the words, "it" and "its" in line 2 of claims 5 and 10 respectively fails to distinctively recite the claimed invention. Claims 6 and 11 are objected to due to their dependent relationship with claims 5 and

10. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Re claims 1 and 12, "a seal" in line 2 appears twice. The examiner respectfully requests the applicant to clarify whether the applicant intends to claim the same seal or two different seals.

If two different seals are recited, then the second one should be -- the seal -- or -- said seal -- in order to maintain a proper antecedent basis and avoid ambiguity.

Dependent claims 2-11 are rejected for their dependency on claim 1.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Haghiri-Tehrani et al. (US 4,617,216).

Re claims 1, 2, 6, and 10, Haghiri-Tehrani discloses a card (Figs. 1-5) with a core (card core or card bed 11) and at least one chip (IC module 5) incorporated into the core (card core or card bed 11), characterized in that at least 5% of at least one main surface (cover films 12 and 13) is covered by a seal (laminating adhesive 17), the chip (IC module 5) is covered on both main surfaces (Figs. 1-5) with a seal or a plastics layer and a recess (cavity 14) of the core (11) and/or a seal exhibit fine structures (Figs. 1-3). The at least one seal (laminating adhesive) consists of plastics (col. 3, ll. 50-53) and extends at no point to the edge of the card.

Re claim 3, Haghiri-Tehrani discloses the card (1) as recited in rejected claim 1 stated above, wherein the core comprises paper or plastics-coated paper (col. 3, ll. 50-60). Haghiri-

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Tehrani further discloses the image-forming layer comprises a photographic layer (The fields 9 and 10 are provided for machine-readable and non-machine-readable embossed data.).

Re claim 5, Haghiri-Tehrani discloses the card as recited in rejected claim 1 stated above, wherein the core comprises at least one image-receiving layer/image forming layer (9 and 10 in Fig. 1) on at least one main surface. The image-receiving layer can be provided with various types of inscription properties that includes a very fine pore.

Re claim 7, Haghiri-Tehrani discloses the card as recited in rejected claim 1 stated above, wherein at least one seal (laminating adhesive 17) covers the recess (cavity 14) for the chip (IC module 5) on at least one side.

Re claim 8, Haghiri-Tehrani discloses the card as recited in rejected claim 1 stated above, wherein, the core (card core or card bed 11) characterized in that the core (11) contains at least one recess (14) with fine structure.

Re claim 9, Haghiri-Tehrani discloses the card as recited in rejected claim 12 stated above, wherein, the chip (IC module 5) is accommodated in the recess (cavity 14).

Re claim 11, Haghiri-Tehrani discloses the card as recited in rejected claim 1 stated above, characterized in that the card (identification card 1) is covered on both main surfaces (cover films 12 and 13) with a plastic layer which projects beyond all the card's edges and the projecting margins of the two layers are welded together (Haghiri-Tehrani discloses as prior art information, a high-frequency welding process for joining the edges of a carrier plate with the card.).

Re claim 12, Haghiri-Tehrani discloses a process of producing an identity card (identification card 1) characterized in that an image is produced on a core of print material (card

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core or card bed 11), a recess (cavity 14) is then created, the chip is inserted once the recess has been covered on one side with a seal (laminating adhesive 17; Fig. 3b) which amount to at least 5% of the main surface, and then the second side of the recess is covered with a seal (cover films 12 and 13) or a plastic layer.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Haghir-Tehrani et al. (US 4,966,857) discloses a method of making an integrated circuit card; Tiffany, III (US 6,025,054) discloses a method of making a smart card; Hagner (US 5,830,561) discloses a card comprising at least one core layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on M, T, R, and Friday 5:30a-4:00p (Maxi-Flex\*).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Steven S. Paik  
Primary Examiner  
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ssp